

### **REMARKS**

This responds to the Office Action mailed on March 24, 2006, and the references cited therewith.

Claims 1 and 4 are amended, claims 13-21 are withdrawn without prejudice to the Applicants; as a result, claims 1-12 are now pending in this application.

### **Interview Summary**

Applicants thank Examiner **Daniel Kesack** for the courtesy of a telephone interview on **March 8, 2006** with Applicants' representative **Joseph P. Mehrle**.

### **Affirmation of Election**

Restriction to one of the following claims was required:

- I. Claims 1-12, drawn to aggregating preferences, and deriving products used by a second population.
- II. Claims 13-21, drawn to generating a subset of preferences, and identifying position changes of a mutual fund from the subset.

As provisionally elected by Applicants' representative, **Joseph P. Mehrle**, during the telephone interview on **March 8, 2006**, Applicant elects to prosecute the invention of Group I, claims 1-12.

The claims of the non-elected invention, claims 13-21, are hereby withdrawn. However, Applicants reserve the right to later file continuations or divisions having claims directed to the non-elected inventions.

### **§112 Rejection of the Claims**

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Although Applicants disagree that the phrase "associated with" is indefinite, Applicants have changed this phraseology to be "identified as," which is clearly not indefinite. Thus, this rejection is no longer valid and should be withdrawn. Applicants also note that the Office has never rejected claims in experience of the Applicants' representative on the basis of the phrase "associated with" being deemed indefinite. In fact, Applicants can point to an abundance of

issued patents that have this phrase. So, unless the MPEP has changed, Applicants believe this rejection was in fact inappropriate because the Office has always permitted this language and if there is a change within the Office now than that change should be memorialized within the MPEP. Therefore, Applicants respectfully request that the Examiner point to a revised MPEP section that now indicates such language is not acceptable. Applicants cannot be treated differently than other Applicants that come before the Office and to reject this language only as to the Applicants and to permit it as to other Applicants is not appropriate and is in fact in error.

Claim 4 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Applicants have amended claim 4 to clarify that the objectives are “predefined.” This removes the asserted indefiniteness or ambiguity with respect to this claim. Accordingly, this rejection should be withdrawn and Applicants respectfully request an indication of the same.

#### §102 Rejection of the Claims

Claims 1-3 were rejected under 35 U.S.C. § 102(e) for anticipation by Reese (U.S. 6,236,980). It is of course fundamental that in order to sustain an anticipation rejection that each and every step or element in the rejected claims must be taught or suggested in the cited reference.

Reese is directed to analyzing existing investment sources and making recommendations from those sources to its subscribers. Reese does not permit selective preferences of users. The Examiner’s attention is directed to column 12 lines 26-33. Here, it can be seen that Reese does not permit a user to identify preference of investments or allocations of investments; rather this is what Reese does not behalf of its users and the users do not participate in this.

Reese also does not derive a financial product in response to a user selected preference and the set of preference to which it related. In other words, Reese uses predefined investment sources, such as Money Magazine, and analyzes it to make recommendations to its subscribers. Reese provides no mechanism or suggestion where a user can be an analyst within a virtual community by selectively providing preferences for investments or allocations of investments and those preferences of the user and the community as a whole is then used to derive an entirely new financial product for the virtual community. In Reese, a user passively receives

recommendations from existing, conventional, pre-selected and pre-defined investment sources that are automatically analyzed on behalf of the user.

Accordingly, Applicants submit that Reese fails to teach or suggest each and every step or element in the rejected independent claim 1. Therefore, the rejections are not sustainable and should be withdrawn. Applicants respectfully request an indication of the same.

§103 Rejection of the Claims

Claims 8-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese. Claims 8-12 are dependent from amended independent claim 1; therefore for the amendments and remarks presented above with respect to claim 1, the rejections of claims 8-12 should be withdrawn. Applicants respectfully request an indication of the same.

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claims 1 and 2 above, and further in view of Segal et al. (U.S. 6,049,783). Claims 4-5 are dependent from amended independent claim 1; thus for the amendments and remarks presented above with respect to claim 1, the rejections of claims 4-5 should be withdrawn. Applicants respectfully request an indication of the same

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claim 1 above, and further in view of Phillips et al. (U.S. 6,473,084). Claim 6 is dependent from amended independent claim 1; therefore, for the amendments and remarks presented above with respect to claim 1, the rejections of claim 6 should be withdrawn. Applicants respectfully request an indication of the same

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claims 1 and 2 above, and further in view of Wallman (U.S. 6,338,047). Claim 7 is dependent from amended independent claim 1; thus, for the amendments and remarks presented above with respect to claim 1, the rejections of claim 6 should be withdrawn. Applicants respectfully request an indication of the same

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

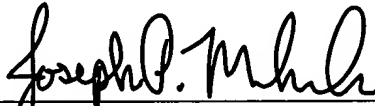
MICHAEL J. WITZ ET AL.

By their Representatives,

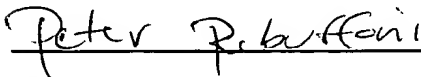
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(513) 942-0224

Date June 26, 2006

By

  
Joseph P. Mehrle  
Reg. No. 45,535

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26 day of June, 2006.

  
Name

  
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